

REMARKS

Applicants respectfully request reconsideration of the present patent application in light of the foregoing amendments and the following remarks.

In the Office Action dated February 22, 2006, the Examiner objected to the title of the application as being not descriptive. The Examiner action suggested a new title. In response, Applicants have amended the title along the lines of the Examiner's suggestion.

The Examiner rejected claims 1, 2, 4, 11, 13, 14, 16, and 23 under 35 U.S.C. § 102(b) as being anticipated by Japanese Publication JP 61-053488 ("Arata"). Additionally, the Examiner rejected claims 3, 12, 15 and 24 under 35 U.S.C. § 103(a) as being unpatentable over either Arata in view of U.S. Patent No. 5,468,130 ("Yamada") (claims 3 and 15) or Arata in view of "design choice" (claims 12 and 24). The Examiner objected to claims 5–10 and 17–22 as being dependent on a rejected base claim, but indicated that these claims would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicants thank the Examiner for indicating claims containing allowable subject matter.

In response, Applicants have amended independent claims 1 and 13 to clarify that the connecting passage is for connecting "the lowest portion" of the motor accommodating chamber with the suction chamber. Conforming amendment are also made to claims 10 and 22. Support for these amendments can be found throughout the specification and drawings, including for example lines 20–23 on page 8 of the specification and Figures 1 and 5. No new matter will be added to this application by entry of these amendments. Entry is respectfully requested.

Claims 1, 2, 4, 11, 13, 14, 16, and 23 are Not Anticipated by Arata.

As noted above, claims 1, 2, 4, 11, 13, 14, 16, and 23 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Japanese Publication Arata. Applicants respectfully traverse this rejection. Independent claims 1 and 13 recite, *inter alia*, “a connecting passage for connecting the lowest portion of the motor accommodating chamber with the suction chamber.” The Examiner contends that the chamber identified by reference numeral 11 in Arata reads on the recited motor accommodating chamber, and that the element identified by reference numeral 2a reads on the recited suction chamber. *Office action*, p. 2. The Examiner further contends that the passages identified by reference numerals 20, 23a and 23 in Arata collectively read on the recited connecting passage, which claims 1 and 13 previous recited as being for “connecting a bottom portion of the motor accommodating chamber with the suction chamber.” *Id.* at p. 3.

Without commenting on the sufficiency of the assertions, Applicants simply note that passages 20, 23a and 23 clearly are not “for connecting the lowest portion of the motor accommodating chamber” with the suction chamber. The following is a reproduction of Figure 3 in Arata:



As made clear from the above discussion, Arata cannot anticipate claims 1 and 13, and therefore these claims are allowable. Additionally, because each one of claims 2, 4, 11, 14, 16, and 23 contains all of the limitation of either claim 1 or claim 13 by virtue of the fact that it depends, either directly or indirectly, from one of those claims, claims 2, 4, 11, 14, 16, and 23 are also not anticipated by Arata and are allowable. Applicants respectfully request withdrawal of

the rejection of these claim 1, 2, 4, 11, 13, 14, 16, and 23 under 35 U.S.C. § 102(b) allowance of these claims.

Claims 3 and 15 are not Unpatentable Over Arata in View of Yamada and Claims 12 and 24 are not Unpatentable Over Arata in View of “Design Choice”.

As noted above, claims 3 and 15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Arata in view of Yamada, and claims 12 and 24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Arata in view of “design choice.” Applicants respectfully traverse these rejections.

With respect to claims 3 and 15, the Examiner admits that Arata does not disclose an electric compressor having a movable scroll having a surface that is plated with nickel phosphorus. *Office action*, p. 4. The Examiner contends that Yamada teaches such a movable scroll, and concluded that it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize a movable scroll having a surface that is plated with nickel phosphorus in the Arata apparatus. *Id.* Without commenting on the disclosure of Yamada with respect to this limitation or on the sufficiency of the combination of Arata and Yamada set forth in the Office action, Applicants note that the Office action did not contend that Yamada teaches an electric compressor having a connecting passage for connecting the lowest portion of a motor accommodating chamber that accommodates an electric motor with a suction chamber of a compression mechanism. Therefore, no combination of Arata and Yamada could result in an electric compressor that includes “a connecting passage for connecting the lowest portion of the

motor accommodating chamber with the suction chamber,” which is a limitation of claims 3 and 15 by virtue of their ultimate dependency from claims 1 and 13, respectively.

Additionally, the Examiner does not contend that Yamada otherwise provides a teaching, suggestion or motivation to modify the passages between the chamber 11 and the chamber 2a in Arata so that it is for connecting the lowest portion of the chamber 11 with the chamber 2a. Applicants review of Yamada confirms that it contains no such teaching of either a connecting passage that reads on the connecting passage recited in claims 1 and 13 or a teaching, suggesting or motivation to modify the passages 20, 23a and 23 in Arata so that they are for connecting the lowest portion of the chamber 11 with the chamber 2a. As such, the Office Action did not establish a *prima facie* case of obviousness because any combination of compressors in Arata and Yamada or modification of the compressor in Arata based on Yamada does not teach or suggest all of the limitations of claim 3 or claim 15. *See* M.P.E.P. § 2143 (8th ed. Rev. 4 Oct. 2005).

With respect to claims 12 and 24, the Examiner admits that “Arata fails to disclose the compressor being used in a vehicle air conditioner.” *Office Action*, p. 5. The Examiner concludes, “One having ordinary skill in the electric scroll compressor art, would have found it obvious to utilize the compressor being used in a vehicle air conditioner, since they are merely design parameters depending on being used for a particular purpose or solving a stated problem.” *Id.* Without commenting on the sufficiency of this conclusion, Applicants note the Examiner’s reference to “design choice” does not constitute a teaching, suggestion or motivation in one of the references identified by the Office Action to modify the compressor disclosed in

Arata so that it contains a “connecting passage for connecting the lowest portion of the motor accommodating chamber with the suction chamber,” which is a limitation of claims 12 and 24 by virtue of their dependency from claims 1 and 13, respectively. Additionally, the Examiner’s reference to “design choice” does not demonstrate that such a motivation was within the knowledge generally available to one of ordinary skill in the art at the time the invention was made. As such, the Office Action did not establish a *prima facie* case of obviousness. See M.P.E.P. § 2143.01.

As made clear from the above discussion, Arata cannot render claims 3, 12, 15, or 24 unpatentable either by itself or in combination with Yamada. Applicants respectfully request withdrawal of the rejection of these claims under 35 U.S.C. § 103(a) and allowance of these claims.

Finally, Applicant has not specifically addressed the rejections of the dependent claims. Applicant respectfully submits that the independent claims, from which they depend, are in condition for allowance as set forth above. Accordingly, the dependent claims also are in condition for allowance. Applicant, however, reserves the right to address such rejections of the dependent claims in the future as appropriate.

Serial No. 10/814,894
Response dated June 13, 2006
Reply to Office Action of February 22, 2006

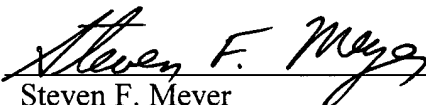
Docket No. 5000-5158

CONCLUSION

For the above-stated reasons, this application is respectfully asserted to be in condition for allowance. An early and favorable examination on the merits is requested. In the event that a telephone conference would facilitate the examination of this application in any way, the Examiner is invited to contact the undersigned at the number provided.

Respectfully submitted,
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